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REMARKSParagraphs 1 - 4 of the Office Action

Claims 1 and 4 are rejected under 35 USC §102(b) as being anticipated by Calverley. Claims 2-3, and 5 are rejected under 35 U.S.C. §103(a) as being unpatentable over Calverley.

Claims 1-4 have been cancelled. The game pieces of the current device each have a particular construction not for aesthetic purposes but to better fit into the game of checkers and the strategy which accompanies that game. In particular, checkers is a strategy game on par with chess, albeit less complicated, but with the same warfare basis. The object of chess, aside from removing your opponents checker men, is to have your checker men made into kings by moving them to the opposite edge of the checker board. Kings, according to the rules of checkers, may move forward and backward and are a more formidable device for eliminating your opponent's checker men. In order to add more excitement to the game, the applicant has altered the pieces from conventional checker chips to civil war soldiers and knights. This will make the game more interesting, particularly for children who will enjoy the pieces themselves.

The Examiner has pointed to Calverley for finding a sectional toy, however Calverley does not show the soldiers or knights as claimed by the applicant. The Examiner gets around this by stating that, "In order to make the game pieces appealing to various aesthetic requirements, it would have been obvious to change [the] look [to a] knight or soldier." However, that the pieces may be changed does not make applicant's game pieces obvious. The law is clear in this regard that there must be motivation found within the prior art to make such a modification.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

- 5 The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original). And again:

- 10 'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although
15 couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

- In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting
20 from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

- As in the cases above, it is respectfully submitted that the Examiner has not given any reason for the modification aside from the fact that the modification is found in applicant's device. For these reasons, it is believed that claims 5 and 6 are each in
25 condition for allowance. Additionally, claim 5, and new claim 6, now further includes the limitation of the game board itself in order to better reference the usage of the game pieces and to better differentiate applicant's device from the prior art.

 The applicant respectfully requests withdrawal of the rejection.

30 New Claim

 New claim 7 has been added to include the method of using the game pieces. As all information therein was disclosed in the specification, it is believed that no new matter or arguments have been added.

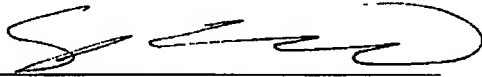
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CONCLUSION

10 In light of the foregoing amendments and remarks, early consideration and
allowance of this application are most courteously solicited.

Respectfully submitted,

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